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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/994,977 | 11/26/2001 | Tsuyoshi Sakata | 4777/6 | 2857 |

29540 7590 12/14/2004

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| EXAMINER |
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NGUYEN, TU X

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| ART UNIT | PAPER NUMBER |
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2684

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,977

Applicant(s)

SAKATA ET AL.

Examiner

Tu X Nguyen

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/12/04 have been fully considered but they are not persuasive.

Regarding claim 1, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the inherent information is not information which is included in the common information, but information which complements the common information") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argument that "the inherent information is received not by a broadcasting means which transmits the common information, but by a communications means". However, Shimomura et al. disclose "communications means" (see 543, fig.5 and col.8 lines 29-30).

Regarding claim 2, applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "permanent/variable information") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Regarding claim 5, applicant's argue that "instruction presence information" has not be discloses. However, Shimomura et al. disclose "the user defines a set of categories that the user finds interesting. These categories are stored in users preferences file. Then, the caching application uses the multimedia descriptor information in conjunction with the set of user preferences". (see col.10 lines 15-22). The receive device 181, which includes "run programs" (see col.14 lines 17-18) is inherently having program "instructions", "executing the instruction" by the communication means (see 541, 543, fig.5).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-7, are rejected under 35 U.S.C. 102(e) as being anticipated by Shimomura et al. (US Patent 6,526,580).

Regarding claim 1, Shimomura et al. disclose a receiving device, comprising:
a broadcast receiving section (see col.4 lines 22-26) receiving data by broadcast means (see 251, fig.2b);
a data accept section accepting the data by communication means (see col.8 lines 24-30); wherein:

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said broadcast receiving section receives common information common to a plurality of receiving devices (see col.2 lines 26-39, "multimedia rich digital information" corresponds to "common information"); and

said data accept section accepts inherent information inherent to the receiving device (see col.2 lines 39-45 and col.4 lines 22-37, "subset of digital information" and "particular digital information stream" correspond to "inherent information").

Regarding claim 2, Shimomura et al. disclose everything as claim 1 above. More specifically, Shimomura et al. disclose the common, inherent information necessary when the data is accepted by the communication means (see col.4 lines 22-37);

A write section writing said common information and said inherent information (see col.4 lines 22-37, "cache" reads on "write").

Regarding claim 3, Shimomura et al. disclose everything as claim 1 above. More specifically, Shimomura et al. disclose receives permanent information which does not change with the passage of time (see col.13 lines 10-45); and said data accept section accepts variable information which changes with the passage of time (see col.5 lines 24-50).

4. Regarding claim 4, Shimomura et al. disclose information indicating links of the hypertext (see col.6 lines 10-16).

Regarding claim 5, Shimomura et al. disclose everything as claim 1 above. More specifically, Shimomura et al. disclose instruction presence information, an instruction by the communications means, executing the instruction (see col.10 line 10 through col.11. line 6).

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Regarding claim 6, Shimomura et al. disclose "acquire the mail" (see col.6 lines 17-34, email services includes popup icon).

Regarding claim 7, Shimomura et al. disclose instruction presence information is information indication indicating presence/absence of information indicating a recording reservation, and said instruction information includes information necessary for a recoding reservation (see col.8 lines 24-42 and col.10 line 10 through col.11 line 6).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is 703-305-3427. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TW

December 7, 2004

NAY MAUNG

SUPERVISORY PATENT EXAMINER